

Attorney Docket No.: RU-0176
Inventors: Ryan and Bagnell
Serial No.: 10/079,040
Filing Date: February 20, 2002
Page 4

REMARKS

Claims 1 and 2 are pending in the instant application. Claims 1 and 2 have been rejected. Claims 1 and 2 have been amended. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims Under 35 U.S.C. 112, Second Paragraph

Claim 1 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the instant invention. The Examiner suggests that the term "the level" in claim 1, line 5, lacks antecedent basis. Applicants have amended the claim to correct the antecedent basis. Withdrawal of this rejection is respectfully requested.

II. Rejection of Claims Under 35 U.S.C. § 102

Claims 1 and 2 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Stewart et al. (1992). The Examiner suggests that this reference teaches a method for measuring levels of relaxin in plasma of a pregnant mare before and after drug treatment, oxytocin, and that the animals stimulated to deliver

Attorney Docket No.: RU-0176
Inventors: Ryan and Bagnell
Serial No.: 10/079,040
Filing Date: February 20, 2002
Page 5

with oxytocin showed an elevation in relaxin levels whereby sensitivity to oxytocin appears to develop late in gestation while mares induced to abort in mid-pregnancy did not show a rise in relaxin. Further, the Examiner suggests the paper teaches that animals that exhibited adverse pregnancy outcomes had depressed relaxin concentrations at some point during gestation prior to the loss. Finally, the Examiner suggests that the preamble of claim 2 recites a diagnostic kit which is given no patentable weight because its contents is not clear. Applicants respectfully traverse this rejection.

The study by Stewart et al. (1992) had two objectives as discussed in detail in the introduction. The first was to obtain relaxin profiles in horses during gestation and the second objective was to examine breed differences in relaxin profiles. Although the paper does discuss measurement of relaxin in blood both before and after administration of a drug, oxytocin, the Examiner's suggestion that this paper describes measurement of relaxin before and after a drug treatment as claimed is not correct. In the instant claims, the method of the present invention is one for predicting efficacy of treatment of a disease or condition that alters placental function. Oxytocin, the drug

Attorney Docket No.: RU-0176
Inventors: Ryan and Bagnell
Serial No.: 10/079,040
Filing Date: February 20, 2002
Page 6

administered in the prior art reference, is a drug that is not used to treat a disease or condition that alters placental function but instead is used simply to induce normal delivery of a foal. Oxytocin is not administered to the animals in the study of Stewart et al. in order to treat any disease or condition but merely as a method to induce a normal foaling. Therefore, contrary to the Examiner's suggestion, this paper does not teach the method of the instant invention which is one where the drug administered is a treatment of a disease or condition that threatens a normal foaling. Accordingly, this paper fails to teach the limitations of the claims as filed and cannot anticipate the instant invention (MPEP 2131). However, in an earnest effort to advance the prosecution of this case, Applicants have amended the claims to make it more clear that the drug treatment used in the instant method is used to treat disease or abnormal condition and actually results in treatment of a disease or abnormal condition, where use of a labor induction agent such as oxytocin would not be applicable. Withdrawal of this rejection is respectfully requested.

Claims 1 and 2 have been rejected under 35 U.S.C. 102(a) as being anticipated by Ryan et al. (2000). The Examiner suggests

Attorney Docket No.: RU-0176
Inventors: Ryan and Bagnell
Serial No.: 10/079,040
Filing Date: February 20, 2002
Page 7

that this paper teaches a method for predicting treatment efficacy in pregnant mares where relaxin levels are measured both before and after drug treatment. Applicants have provided herewith a declaration by the inventors of the instant application showing that the paper cited by the Examiner was their own work and was printed less than one year before the priority date of the instant application, which is February 22, 2001, the filing date of U.S. Provisional Application 60/270,971. Accordingly, this paper cannot anticipate the instant claims and withdrawal of this rejection is respectfully requested.

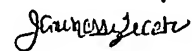
III. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly,

Attorney Docket No.: RU-0176
Inventors: Ryan and Bagnell
Serial No.: 10/079,040
Filing Date: February 20, 2002
Page 8

favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



Jane Massey Licata
Registration No. 32,257

Date: September 19, 2003

Licata & Tyrrell P.C.
66 E. Main Street
Marlton, NJ 08053

856-810-1515